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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): NAI1P486/01.060.01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on June 12, 2006

Signature: Erica L. Farlow

Typed or printed name: Erica L. Farlow

Application Number	Filed
09/975,991	10/15/2001

First Named Inventor: N. Hursey et al.

Art Unit	Examiner
2135	To, B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 41,429
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

REMARKS

The Examiner has objected to Claims 1, 9, and 17 due to informalities. Specifically, the Examiner objected to the limitation "have been written to a data storage device." Applicant asserts that, after reviewing the claims and specification, such limitation is indeed definite, supported by the specification, etc. If the Examiner wishes to discuss such issue in more detail, he is invited to contact the undersigned.

The Examiner has rejected Claims 1-27 under 35 U.S.C. 103(a) as being unpatentable over Cozza (U.S. Patent No. 5,502,815) in view of Waldin et al. (U.S. Patent No. 6,094,731). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, the Examiner has relied on Col. 3, lines 35-40 from Cozza to make a prior art showing of applicant's claimed "storing data identifying computer files that have been written to a data storage device and for which a scan for malware has yet to be performed."

Applicant respectfully asserts that such excerpt relates to storing information on states of files such that changes in a fork size of the stored information may be utilized for determining a subset of viruses to scan for (see Abstract). Clearly, such excerpt does not even suggest applicant's claim language where "data [is stored that] identify[ies] computer files that have been written to a data storage device **and** for which a scan for malware has yet to be performed" (emphasis added).

In the Office Action mailed 03/10/2006, the Examiner argued that "Cozza explicitly discloses this information is stored in a cache in a non-volatile storage medium and when files are subsequently scanned for viruses (see Abstract)." After again reviewing Cozza, it is noted that the Abstract of Cozza discloses that the initial state information concerning the file "is stored in a cache in a non-volatile storage medium and when files are subsequently scanned for viruses, the current state information is compared to the initial state information stored in the cache." Clearly, storing the initial

state information of a file in a cache fails to even suggest "storing data identifying computer files that have been written to a data storage device and for which a scan for malware has yet to be performed" (emphasis added), as claimed by applicant. Applicant's claimed technique requires that the files and data identifying the same are to be written and stored, respectively.

Additionally, the Examiner relied upon Col. 3, lines 45-65 and Col. 6, lines 10-45 to make a prior art showing of applicant's claimed "scanning code operable as a low priority task within a multitasking environment to conduct malware scanning upon computer files identified within said pending scan database as haven been written to the data storage device and for which the scan for malware has yet to be performed" (see the same or similar, but not identical language in each of the independent claims). For substantially the same reasons as argued above, applicant respectfully asserts that neither Cozza nor Waldin teach "scanning code operable as a low priority task within a multitasking environment to conduct malware scanning upon computer files identified ... as haven been written to the data storage device and for which the scan for malware has yet to be performed," as presently claimed by applicant. Specifically, applicant asserts that the excerpts from Waldin relied upon by the Examiner fail to disclose "a low priority task" that operates on computer files identified "as haven been written to the data storage device and for which the scan for malware has yet to be performed" (emphasis added), as claimed by applicant.

In the Office Action mailed 03/10/2006, the Examiner argues that 'this argument does not make sense because Applicant did not claim this limitation "as haven been written to a data storage device and for which a scan for malware has yet to be performed" as discussed in the previous Office action.' In response, applicant asserts that the claim language is indeed claimed (see previous amendments) and is definite, supported, etc.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or

in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,*947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 2 et al., the Examiner has relied on Col. 2, line 55-Col. 3, line 8 from Cozza to make a prior art showing of applicant's claimed "file write code operable as a computer file is written to a storage device to add data identifying said computer file to said pending scan database."

Applicant respectfully asserts that such excerpt only teaches that "information detailing the initial 'state' of an uninfected file...can be 'cached'." However, Cozza does not teach when such state information is stored, but only that the file must be in an initial state. Clearly, only generally teaching storing initial state information of a file, as in Cozza, does not meet applicant's specific claim language, namely that "as a computer file is written to a storage device...data identifying said computer file [is added] to said pending scan database" (emphasis added). Furthermore, Cozza only teaches that the state information is stored, but not that it is stored to a "pending scan database," as claimed by applicant. In fact, Cozza only scans a current state data, which would not require the initial state information to be stored in a pending scan database.

With respect to Claim 4 et al., the Examiner has relied on Col. 3, lines 35-40 in Cozza to make a prior art showing of applicant's claimed "scanned file database code operable to maintain a scanned file database storing data identifying computer files that have been scanned for malware." Applicant respectfully asserts that such excerpt only teaches storing information on a current state and prior states of a file. When read in context, Cozza stores such states for determining what set of viruses to scan the associated file for (see Abstract). Thus, Cozza does not teach a "scanned file database...[for] storing data identifying computer files that have been scanned for malware" (emphasis added).

With respect to Claim 7 et al., the Examiner has relied on Col. 3, lines 35-55 in Cozza to make a prior art showing of applicant's claimed "initiation code operable upon startup to detect any computer files stored on a storage device not included within either said pending scan database or said scanned file database and to add such computer files to said pending scan database."

Applicant respectfully asserts that Cozza only teaches storing states of files and using such states to scan each file "stored in a memory system." However, Cozza does not specifically teach a "pending scan database" and "scanned file database", let alone detecting "upon startup... any computer files stored on a storage device not included within either said pending scan database or said scanned file database and...add[ing] such computer files to said pending scan database," as claimed by applicant (emphasis added).

Further, with respect to Claims 25 and 27, the Examiner, in the Office Action mailed 03/10/2006, has relied on Col. 3, lines 50-67 and Col. 4, lines 15-60 in Cozza to make a prior art showing of applicant's claimed technique "wherein an order of said computer files identified within said pending scan database being scanned is based on an algorithm that estimates the likelihood of a read request being performed on each computer file" (see Claim 25) and "wherein an order of said computer files identified within said pending scan database being scanned is based on the order in which said computer files were placed in said pending scan database" (see Claim 27).

Applicant respectfully asserts that the excerpts from Cozza relied upon by the Examiner disclose that "[f]or each file on a volume that is to be scanned, the cache is searched for the presence of the file's cache information in step 40." However, merely searching for the file's cache information simply fails to even suggest any "order of said computer files identified within said pending scan database," as claimed by applicant. Furthermore, the excerpts from Cozza fail to disclose that the ordering is "based on an algorithm that estimates the likelihood of a read request being performed on each computer file" or that the ordering is "based on the order in which said computer files were placed in said pending scan database," as claimed by applicant.

Also, with respect to Claim 26, the Examiner, in the Office Action mailed 03/10/2006, has relied on Col. 4, line 59 to Col. 5, line 7 in Cozza to make a prior art showing to applicant's claimed technique "wherein only computer files determined to be clean from the malware scanning are stored in the scanned file database."

Applicant respectfully asserts that the excerpts from Cozza relied upon by the Examiner disclose that "[i]f a virus was found, then the scan cache is updated with zeroed information for the file in step 60" (emphasis added). However, updating the scan cache with zeroed information for a file found to have a virus *teaches away* from a technique "wherein only computer files determined to be clean from the malware scanning are stored in the scanned file database" (emphasis added), as claimed by applicant.